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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. |
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| 09/634,041 | 08/08/00 | RYAN | F-175 |

TM02/0430

RONALD REICHMAN
PITNEY BOWES INC
INTELLECTUAL PROPERTY AND TECHNOLOGY LAW
35 WATERVIEW DRIVE P O BOX 3000
SHELTON CT 06484

| EXAMINER |
|---------------|
| FISCHEITTI, J |

| ART UNIT | PAPER NUMBER |
|----------|--------------|
| 2167 | |

DATE MAILED: 04/30/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/634,041

Applicant(s)

RYAN ET AL.

Examiner

Joseph A. Fischetti

Art Unit

2167

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 August 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) ☒ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 18) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other: _____.

Art Unit: 2167

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-28 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1, it is unclear in section C what is meant by "collecting by sellers the correct sales and/or use tax".

In section E it is unclear what is meant by "segmenting".

Claims 10, 14, 15, the use of "may" is indefinite.

Claims 11, 13 and 23 and 24 fail to further limit the scope of the invention by failing to recite the steps which cause the effect, i.e., secrecy, notification, identification.

Claim 12 "fraud" should be defined since it is a legal conclusion.

Claim 18, "strange" is vague.

Claim 27, "other" connotes that there is a one, but it has not been recited.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-5, 8-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over
Chong in view of Francisco et al¹ and Appendix A of RFP 6/1/200.

Art Unit: 2167

Chong discloses a method of collecting information on remote sales by buyers (col. 4 lines 46-52); calculating correct tax for jurisdiction (col. 4 lines 61-62); collecting by sellers the correct sales tax and/or use tax (col. 1, line 18) and segmenting (see Appendix G of Chong), but not segmenting by an agent. However there is no disclosure of collecting by an agent, and paying of taxes to respective jurisdictions.

However, Francisco et al. and Appendix A of RFP 6/1/200 disclose collecting by an agent and paying the sales tax (col.1 lines 45-50)/p.25 Model 1 of the RFP. It would be obvious to modify the method of Chong to use the collecting and paying agent disclosed in Francisco et al. to effect delivery of tax revenues to the collecting authority since it would lessen the occurrences of retailers not paying the tax to the state authorities as suggested by Francisco et al. at col.2 lines 19-25. Whether the segmenting occurs by the retailer as disclosed by Chong or at the agent is deemed to be a matter of mere reversal of steps.

Re claim 2: see step 71 of Francisco et al.

Re claim 3: see Appendix G of Chong.

Re claims 5,8, see col.6 lines 45-70 of Chong.

Re claim 9, see Appendix A of Chong

Re claim 10: see Francisco et al. col. 8 lines 15-21.

Re claims 12, 17 24 and 25 the use of the main frame system provided by Francisco et al. (see col.8 lines 22-34) which inherently allows for the type of monitoring recited which is deemed to be a mere obvious variant of the systems disclosed when taken with the RFP Model 2 disclosure of auditing of the system and the proposed

Art Unit: 2167

ways as recited in these claims amount to no more than recognized audit procedures. Likewise, regarding the remaining claims dealing with notice, review and access of information, the use of such a network would lend itself to like obvious variants.

Claims 6,7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chong in view of Francisco et al. and Appendix A of RFP 6/1/200 as applied to claims 1-5, 8-28 above, and further in view of Longfield. Longfield discloses the filing of tax returns and the financing by an agent. It would be obvious to provide such a feature for the agent in the above proposed combination because this would desirably reduce steps.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication should be directed to Joseph A. Fischetti at telephone number (703) 305-0731.

A handwritten signature in black ink, appearing to read "J A Fischetti". The signature is stylized with a large, sweeping "F" and a trailing flourish.